

REMARKS

Claims 1-20 are pending in the present application. Claims 1, 8, 9, 16, and 17 are amended. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The examiner rejects claim 8 as indefinite. Applicants have amended claim 8 accordingly.

II. 35 U.S.C. § 102, Anticipation

The examiner rejects claims 1-6, 9-14, and 16-20 as anticipated by *Manes, Total Axis Self Adjusting Pass-Through Port*, U.S. Patent No. 6,574,173 (June 3, 2003). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Claim 1 as amended is as follows:

1. An automated tape library system, comprising:
a first tape library;
a second tape library located adjacent to said first tape library; and
an exchange unit for transporting at least one tape storage unit from said first tape library to said second tape library, said exchange unit arranged between said first tape library and said second tape library, said exchange unit comprising:
a movable transport unit, said movable transport unit for transport of said at least one tape storage unit from said first tape library to said second tape library;
a movable drive unit, said movable drive unit linked to said movable transport unit; and

Page 6 of 12
Gupta et al. - 10/790,608

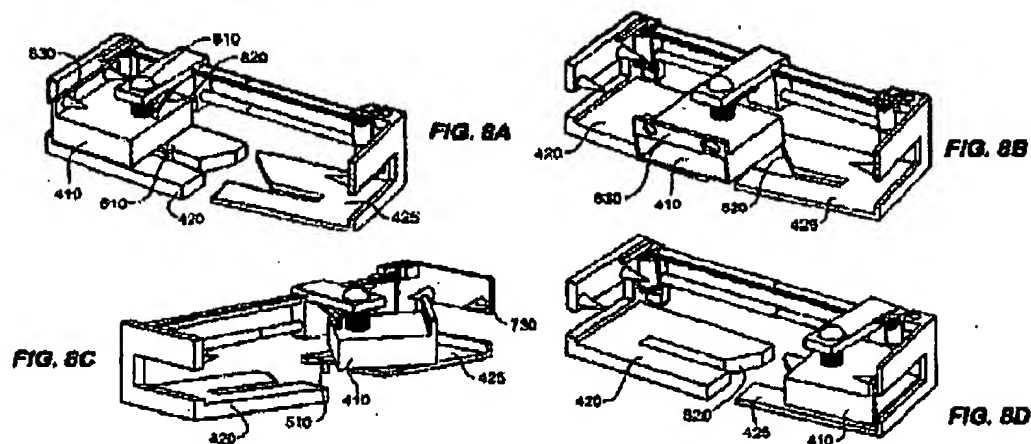
a direction translation unit coupled to said movable transport unit and said movable drive unit, said direction translation unit operable to translate a forward and reverse stroke of the movable transport unit in a first axis directed parallel to a sidewall of said first tape library and a sidewall of said second tape library to a radial movement of said movable transport unit directed toward and away from said sidewall of said first tape library or toward and away from said sidewall of said second tape library.

Manes does not anticipate claim 1 because Manes does not show the feature emphasized above. The examiner asserts otherwise, stating that:

Manes Figures 8A-10 meet all the limitations of claims 1, 9, 11, 17, and 19, including exchange unit (400) comprising a movable transport unit (410), movable drive unit (450/470/490) wherein the motor and belt move and therefore comprise a movable drive unit that is linked to the transport unit by the pivot (430), and a direction translation unit (420/425) coupled to the transport unit and drive unit through at least the ball joint, the corner of the terminal port (420), and the cam follower (510). The translation unit is operable to translate forward and reverse stroke in an axis parallel to sidewalls of library 1 and library 2, in at least the case where the two libraries are the same size and lines up next to each other and where the side walls are defined as the walls in Figure 10 closest to the labels "LIBRARY 1" and "LIBRARY 2," to a radial movement toward and away from the sidewalls as the cam follower (510) follows the left and right cam surfaces (520).

Office Action of June 28, 2005, pp. 2-3.

However, the device shown in figures 8A-10 of Manes do not show all of the features of claim 1. Figures 8A through 10 are as follows:



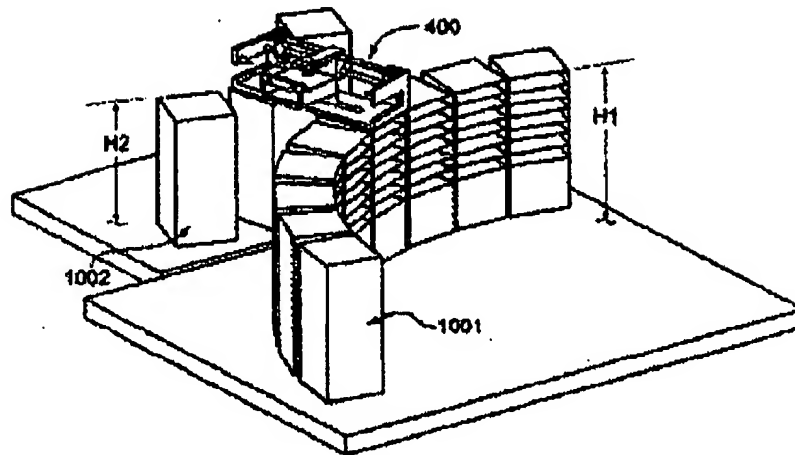


FIG. 9

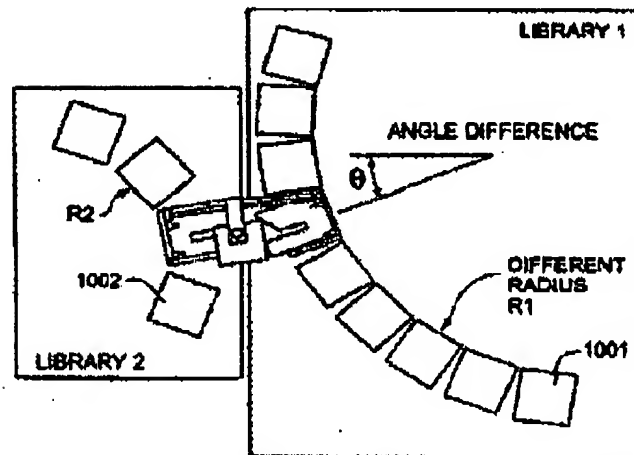


FIG. 10

Contrary to the examiner's assertions, these figures show that Manes does not anticipate claim 1. Applicants assume, for purposes of this argument only, that reference numeral 400 is the claimed exchange unit, that reference numeral 410 is the claimed movable transport unit, that reference numerals 450, 470, and 490 together form the claimed movable drive unit, and that reference numerals 420 and 425 together form the claimed direction translation unit. However, Applicants do not concede that these reference numerals actually correspond to the claimed terms.

Even assuming that the various components of Manes correspond to the claimed terms, Manes still does not show that the direction translation unit is operable to translate a forward and reverse stroke of the movable transport unit in a first axis directed parallel to a sidewall of said

first tape library and a sidewall of said second tape library to a radial movement of said movable transport unit directed toward and away from said sidewall of said first tape library or toward and away from said sidewall of said second tape library, as claimed. Instead, Manes shows a device where the transport unit 410 moves between two storage libraries, and accounts for angular differences between the libraries via moving the transport unit 410 along tracks in portions 420 and 425. The movable transport unit performs radial movement relative to the storage library sidewalls while changing angles between portions 420 and 425. The movable transport unit changes angles between portions 420 and 425 via a post 510 that moves within the tracks. As shown in figure 9 and figure 10 of Manes, if movable transport unit 410 moves parallel to a side wall of both library 1 and library 2, then movable transport unit 410 moves in a straight line along the track in portions 420 and 425. Moveable transport unit 410 moves straight because when the side walls of both library 1 and library 2 are parallel, the track in portion 420 exactly aligns with the track in portion 425. Thus, when the Manes device is in the claimed orientation, the movable transport unit 410 moves straight and parallel relative to the sidewalls. The movable transport unit 410 does not have a radial movement directed toward and away from either sidewall in the manner claimed in claim 1. Thus, the devices shown in figure 8A through figure 10 in Manes does not show all of the features of claim 1.

On the other hand, if the movable transport unit 410 is capable of moving radially relative to the sidewalls, then the tracks in portions 420 and 425 are not aligned along a straight line. Radial movement of movable transport unit 410 requires that the movable transport unit 410 pivot as it switches tracks between portions 420 and 425. However, if the tracks in 420 and 425 are not aligned along a straight line, then at least one of portions 420 and 425 must be oriented at an angle different than the other portion. Because, in this case, portions 420 and 425 are at different angles with respect to each other, least one of portions 420 and 425 must be not parallel to at least one of the sidewalls in library 1 and library 2. Thus, in this case, the device shown in the Manes figures does not move along a first axis directed parallel to a sidewall of both the first and second libraries, as claimed.

As shown above, the device shown in Manes physically cannot simultaneously perform all of the functions and features claimed in claim 1. If the tracks in 420 and 425 are aligned, then the movable transport unit 410 does not move radially directed toward and away from one of the sidewalls of the first and second tape libraries, as claimed. If the tracks in 420 and 425 are not

aligned, then the forward and reverse stroke of the movable transport unit is not in a first axis directed parallel to a sidewall of said first tape library and a sidewall of said second tape library. For this reason, Manes does not show all of the features of claim 1. Accordingly, Manes does not anticipate claim 1.

Nevertheless, the device shown in the Manes figures shows that movable transport unit 410 may pivot around ball joint 810 and a spring 820 may be provided to provide a biasing force that tends to return movable transport unit 410 to a predetermined position. As movable transport unit 410 pivots about ball joint 810, movable transport unit rotates around an axis perpendicular to the top surface of movable transport unit 410. However, as posited by the examiner and assumed for the sake of this argument, the direction translation unit corresponds to portions 420 and 425. As claimed, the "direction translation unit [is] operable to translate a forward and reverse stroke of the movable transport unit in a first axis directed parallel" to sidewalls of both libraries. However, the spring 820 is not a part of the direction translation unit, portions 420 and 425. Thus, the spring cannot serve the claimed function. As described above, portions 420 and 425 cannot operate in a way to cause movable drive unit 410 in a way that satisfies the requirements of claim 1. Thus, even if motion of movable drive unit 410 caused by rotation of the spring results in radial movement directed toward and away from said sidewalls, a point that Applicants do not concede, then the spring still does not meet the required features of claim 1 because the spring is not a part of the direction translation unit. Moreover, the motion of movable transport unit 410 caused by rotation of the spring causes the movable transport unit to rotate with respect to movable drive unit 420 and 425, not to actually move radially toward and away from the sidewalls of the first and second libraries, as claimed. Thus, again, the devices shown in the Manes figures do not show all of the features of claim 1. Accordingly, Manes does not anticipate claim 1.

Independent claims 9 and 17 have been amended to include the above features described vis-à-vis claim 1. Thus, for similar reasons, Manes does not anticipate independent claims 9 and 17.

Regarding the remaining dependent claims, the same distinctions between *Manes* and the invention of claim 1 can be made for the dependent claims. Additionally, the rejected dependent claims claim other additional combinations of features not suggested by the reference. For example, Manes does not show that radial movement of the movable transport unit comprises a

movement guided by a radial track, as claimed in claim 6. The track shown in *Manes* is not a radial track. Thus, *Manes* does not anticipate claim 6.

Applicants have shown that *Manes* does not show all of the features of the claims. Therefore, the rejection of claims 1-6, 9-14, and 16-20 under 35 U.S.C. § 102 has been overcome.

Furthermore, *Manes* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the examiner pointing out some teaching or incentive to implement *Manes* and the features of claim 1, one of ordinary skill in the art would not be led to modify *Manes* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Manes* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

III. Objection to Claims

The examiner states that claims 7, 8, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 7, 8, and 15 should also be allowable because the independent claims from which claims 7, 8, and 15 depend should also be allowable over *Manes*.

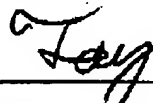
IV. Conclusion

It is respectfully urged that the subject application is patentable over *Manes* and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: September 28, 2005

Respectfully submitted,



Theodore D. Fay III
Reg. No. 48,504
Duke W. Yee
Reg. No. 34,285
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicants